

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:) Examiner: Angela Marie Hoffa
Thomas KOEHLER et al.)
Serial No.: 10/598,004) Art Unit: 3768
Filed: May 10, 2007) Confirmation No.: 8994
February 15, 2005)
as PCT/IB2005/050576)
For: **DRUG APPLICATION**)
DURING A CT SCAN) Cleveland, Ohio 44143
Attorney Docket: DE040056US)

RESPONSE TO NOTICE OF NON-COMPLIANT
PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir / Madam:

These remarks are being filed in response to the Notice of Non-Compliant Pre-Appeal Brief Request for Review, mailed October 19, 2010. That Notice indicates the Pre-Appeal Brief Request for Review filed on October 15, 2010 is non-compliant because an "after-final or proposed amendment was filed with the Request", and therefore a pre-appeal brief conference will not be held by the USPTO. That is an inaccurate statement of the record, for the reasons provided below. Therefore, the applicants respectfully request that the USPTO hold a pre-appeal conference based on the Pre-Appeal Brief Request for Review filed on October 15, 2010.

CERTIFICATE OF ELECTRONIC TRANSMISSION

I certify that this communication in connection with U.S. Serial No. 10/598,004 is being filed on the date indicated below by electronic transmission with the United States Patent and Trademark Office via the electronic filing system (EFS-Web).

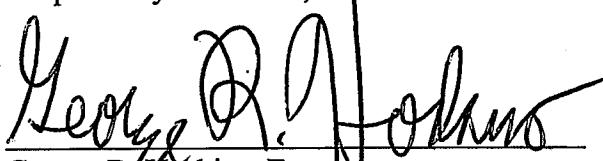
October 27, 2010
Date

Patricia A. Heim
Patricia A. Heim

The Pre-Appeal Brief Request for Review was accompanied by an After-Final Communication on October 15, 2010. However, that After-Final Communication was not an "amendment" because no amendments were requested to be made to the application, including the claims. Rather, the After-Final Communication was filed in order to comply with 37 C.F.R. § 1.133, which provides: "In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant." Thus the remarks in the After-Final Communication are limited to summarizing the discussions during the telephonic interview which took place on October 6, 2010. As properly identified in the Listing of Claims in the After-Final Communication, each claim was either an original claim or was previously presented -- no claim was amended, nor was the patentability of the pending claims even discussed in the After-Final Communication. To hold that the October 15, 2010 After-Final Communication is an "amendment" on this record would ignore the meaning of that word. An interview summary is not an amendment.

For the foregoing reasons, the After-Final Communication which accompanied the Pre-Appeal Brief Request for Review on October 15, 2010 was not an amendment. Therefore, it is respectfully submitted that the Pre-Appeal Brief Request for Review was proper, and it is requested that the Office hold a pre-appeal conference based on that Request.

Respectfully submitted,



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